

### C. Remarks

The claims are 17-26 and 28-32, with claim 17 being the sole independent claim. Claim 27 has been cancelled. Claim 17 has been amended to include the features of cancelled claim 27 and to better define the present invention. Support for this amendment may be found throughout the specification and the drawings. Claim 18 has been amended to correct an informality. No new matter has been added. Reconsideration of the claims is expressly requested.

Claim 18 has been objected to because of an informality. Applicants have corrected the informality and respectfully request withdrawal of the objection.

Claim 21 stands rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. Specifically, the Examiner has alleged that the phrase “closely contacted with the material” is inconsistent with the recitation in claim 17 that the medium is on the material to be treated. This rejection is respectfully traversed.

According to the present application, the medium may be placed on the material to be treated and yet not be “closely contacted” therewith. In particular, as noted in the original specification on page 39, lines 5-9, if the surface roughness of the non-adhering medium is more than 5,000 nm in root mean square, the medium does not closely contact the material to be treated even if the medium is placed on the material. Accordingly, it is clear that claim 21 is consistent with claim 17 and the indefiniteness rejection should be withdrawn.

Claims 17, 19-24, 26, 27 and 31 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 4,603,089 (Bampton). Claims 17, 19-21

and 23-27 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 5,321,227 (Fuchs). Claims 29 and 30 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious from Bampton or Fuchs. The grounds of rejection are respectfully traversed.

Prior to addressing the merits of rejection, Applicants would like to briefly review some of the features of the presently claimed invention. The present invention, as is now claimed, is directed to a non-contact treatment in which a non-adhering medium capable of absorbing the energy is placed on a material to be treated and is irradiated with energy. The treatment is cutting or welding, which is carried out on a back side of the non-adhering medium capable of absorbing the energy, i.e., a side opposite to a beam irradiation side.

Bampton is directed to laser welding of sandwiched structures. Bampton, however, does not disclose or suggest that welding is carried out on a back side of the non-adhering medium capable of absorbing the energy. Accordingly, this reference cannot anticipate the presently claimed invention or render it unpatentable.

Fuchs cannot provide the teachings missing in Bampton. Fuchs is related to the deep cutting of a material covering a substrate using a laser beam. However, like Bampton, Fuchs fails to disclose or suggest the presently claimed treatment carried out on a back side of the non-adhering medium capable of absorbing the energy. Accordingly, whether considered alone or in combination with Bampton, Fuchs cannot affect the patentability of the presently claimed invention.

Wherefore, Applicants respectfully request that the outstanding rejection be withdrawn and that the present case be passed to issue. It is also respectfully requested that the Examiner acknowledge Applicants' claim to priority from U.S. Application No. 09/219,597 under 35 U.S.C. §§ 120 and/or 121.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

  
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